

Paper No. 29
EWH/cj

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 8/27/99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Platinum Technology, Inc.

Serial No. 74/523,159

Martin R. Greensten of Techmark for Platinum Techonology,
Inc.

Rita M. Odin, Trademark Examining Attorney, Law Office 109
(Deborah S. Cohn, Managing Attorney)

Before Hanak, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Platinum Technology, Inc. (applicant) seeks to
register in typed drawing form PLATINUM OBJECT TRACKER for
"computer software for use in the field of databases,
database management and administration, database design and
implentation, database query and reporting, programming and
application development and instructional manuals

distributed therewith." The application was filed on May 14, 1994 with a claimed first use date of April 15, 1993.

In the first office action, the Examining Attorney stated that "applicant must disclaim the descriptive wording OBJECT TRACKER apart from the mark as shown." In support of her theory that OBJECT TRACKER is descriptive of applicant's goods, the Examining Attorney made of record excerpts of three stories appearing in the NEXIS database.

In response, applicant disclaimed the exclusive right to use OBJECT apart from the mark as shown. However, applicant refused to disclaim the phrase OBJECT TRACKER. Applicant noted that the first of the three NEXIS excerpts showed "applicant's own use of OBJECT TRACKER as a trademark," and that the second and third excerpts (both of which came from the same article) apparently dealt with the tracking of physical objects such as missiles and satellites and hence these excerpts "would not be applicable to database software such as that on which applicant uses its mark."

In the second office action, the Examining Attorney made of record additional excerpts from the NEXIS database which she contends demonstrates that the phrase OBJECT TRACKER is descriptive of applicant's goods and hence must be disclaimed in its entirety.

In response, applicant submitted a list of various TRACKER marks for computer software and computer programs wherein the PTO did not require a disclaimer of TRACKER. Applicant contends that these third party marks demonstrate that TRACKER is not descriptive as applied to computer software or computer programs.

In response, the Examining Attorney made the following comments in office action three at page 4: "Applicant claims that the allowance of numerous other marks including the word(s) ... 'track' or 'tracker' obligate the Examining Attorney to withdraw the full disclaimer requirement and pass this application to publication. Third-party registrations are not conclusive on the question of descriptiveness. The Examining Attorney must consider each case on its own merits." In this third (and final) action, the Examining Attorney did not in any way indicate to applicant that it must submit copies of the registrations which applicant referenced. Instead, the Examining Attorney made of record copies of other third-party registrations containing the word TRACKER wherein said word was disclaimed.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining

Attorney filed briefs. Applicant did not request a hearing.

At the outset, one evidentiary matter must be disposed of. At page 6 of her brief, the Examining Attorney argues that applicant's "third-party registrations were not properly made of record." In response, applicant's attorney attached to his reply brief copies of the third-party registrations which he referenced, as well as additional third-party registrations which issued subsequent to the conclusion of the examination process.

Because the Examining Attorney did not, during the course of the examination process, object to applicant's simply referencing certain third-party registrations, the Examining Attorney's argument in her brief that these registrations have not been properly made of record is not well taken. In re Nashua Corporation, 229 USPQ 1022, 1023 n.3 (TTAB 1986) ("Although the Examining Attorney in her brief notes that actual copies of these [third-party] registrations had not been submitted for the record, throughout the examination process she considered applicant's arguments concerning these registrations and argued in response to them. ... Because she treated them as if they were of record we will accept applicant's

submission with its reply brief on appeal as properly making them of record.").

Considering first the third-party registrations submitted both by applicant and the Examining Attorney, we note that applicant correctly argues at page 4 of its brief that third-party registrations can be used as a supplement to dictionaries to demonstrate how the relevant purchasing public interprets a particular word or phrase. More precisely, third-party registrations can be utilized to show that a particular word or phrase is suggestive (and not descriptive) when applied to certain goods or services. Spoons Restaurants Inc., v. Morrison Inc., 23 USPQ2d 1735, 1740 (TTAB 1991). ("Third-party registrations, of course, may be used to indicate that a commonly registered element has a suggestive meaning for particular goods or services...").

Turning to a consideration of the third-party registrations, we note that virtually all of those submitted by applicant are for computer software or computer programs, whereas the third-party registrations submitted by the Examining Attorney are evenly split between those dealing with computer software and computer programs, and those dealing with other types of goods or services.

Having reviewed all of the third-party registrations, we come to the conclusion that the PTO has taken a very inconsistent position with regard to whether the word TRACKER is suggestive or descriptive when applied to computer software or computer programs. For example, one simply cannot fathom why the following marks were registered on the Principal Register for computer software without any disclaimer of TRACKER if said word is descriptive in the computer field, as contended by the Examining Attorney: ORDER TRACKER; PART TRACKER; CUSTOMER TRACKER; IRA TRACKER; PACKER TRACKER; LABOR TRACKER; QUOTE TRACKER; FREQUENT FLYER AWARD TRACKER; and TEXTBOOK TRACKER.

On the other hand, the Examining Attorney has made of record a lesser number of third-party registrations for computer software and computer programs wherein the word TRACKER has been disclaimed. A review of all of the third-party registrations indicates that in their totality, said registrations very slightly favor applicant's position, but also reaffirm the principle that each case must be decided on its own facts.

In arguing that TRACKER is not descriptive of its computer software, applicant notes that the Examining Attorney was simply unable to locate this word in any

specialized computer dictionary, and that none of the definitions of this word found in general dictionaries is of any relevance as applied to computer software. In contrast, applicant notes that the term OBJECT in its mark does appear in one specialized computer dictionary, and it was on this basis that applicant elected to voluntarily disclaim the term OBJECT when requested by the Examining Attorney to do so.

Finally, applicant notes that, as demonstrated by many of the third-party registrations made of record by the Examining Attorney, the word TRACKER is most often used in a descriptive manner in conjunction with devices which track physical objects or which track electronic transmissions such as television signals, radio signals or laser beams. According to applicant, its use of the phrase OBJECT TRACKER in connection with computer software would cause purchasers of said software to engage in "significant mental gymnastics" because the term TRACKER is so strongly associated with the tracking of physical objects or electronic transmissions. There is no dispute that applicant's software performs neither of the two foregoing functions. (Applicant's brief page 4).

The Examining Attorney's best evidence that OBJECT TRACKER is, in its entirety, descriptive of applicant's

computer software is one of the three original NEXIS excerpts which she made of record with her first office action. That excerpt is from the August 1, 1994 issue of a publication called "Edge" and it reads in pertinent part as follows: "PLATINUM OBJECT TRACKER -- Tracks usage of QMF queries and procedures. ... Object Tracker now tracks data and table activity." According to the Examining Attorney, on its face this NEXIS excerpt demonstrates that the word TRACKER is descriptive when applied to applicant's software.

In response, applicant notes that this excerpt from "Edge" depicts applicant's mark PLATINUM OBJECT TRACKER in all capital letters, and that it later depicts the OBJECT TRACKER portion of applicant's mark with initial capital letters. According to applicant, this demonstrates that applicant's mark is being used not in a descriptive manner, but rather in a trademark manner. More importantly, applicant argues that its computer software analyzes data, and that if any "tracking" is occurring, it is being done by QMF, which, according to applicant, is an initialism for Query Management Facility. Given the fact that this NEXIS excerpt made of record by the Examining Attorney is so truncated, we are simply unable to ascertain with any

degree of certainty as to whether applicant's latter contention is correct or not.

In sum, we find this to be an extraordinarily close case which is replete with doubt. According to long standing Board practice, it is our policy to resolve doubts on the issue of descriptiveness in applicant's favor and pass the mark to publication for possible opposition by competitors or others. See In re Gourmet Bakers Inc., 173 USPQ 565 (TTAB 1972). This is a particular appropriate procedure in this proceeding in view of the fact that the PTO has in recent years repeatedly allowed marks to be registered on the Principal Register for computer software and programs without a disclaimer of TRACKER. The use of the word TRACKER in many of these third-party registrations appears to be decidedly more descriptive in nature than is the use of the word TRACKER in applicant's mark PLATINUM OBJECT TRACKER.

Decision: The refusal to register is reversed.

E. W. Hanak

P. T. Hairston

Ser No. 74/523,159

B. A. Chapman
Administrative Trademark Judges
Trademark Trial and Appeal Board